

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for courtesies extended during the Examiner Interview conducted on March 7, 2006.

Disposition of Claims

Claims 1-13, 18-22, and 29-30 are currently pending in this application. Claims 1 and 18 are independent. The remaining claims depend, directly or indirectly, from claims 1 and 18.

Interview Summary

During the Examiner Interview conducted on March 7, 2006, Applicant and the Examiner discussed the claim limitation “wherein the receiver/decoder is not IP enabled.” The Examiner suggested replacing this phrase with “wherein the receiver/decoder indirectly accesses the network,” to avoid the use of a negative limitation (*i.e.*, the word “not”). Thus, the claims have been amended in accordance with the Examiner’s suggestions. Applicant respectfully asserts that the claim limitation “wherein the receiver/decoder indirectly accesses the network” recites the same subject matter that the previous limitation recited, and therefore, no new search or consideration is required at this stage.

Claim Amendments

The claims have been amended to recite that the receiver/decoder indirectly accesses the network via a gateway interposed between the receiver/decoder and the remote server. Support for this amendment may be found, for example, on pages 4-5 of the Specification. Applicant asserts that no new matter is added by way of this amendment.

Rejections under 35 U.S.C. 103(a)

Claims 1-11 and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,983,273 (“White”) in view of U.S. Patent No. 6,788,882 (“Greer”). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

The claimed invention relates to a method for enabling a receiver/decoder, which is not IP enabled, to access a network. In particular, the claims have been amended, in part, to recite “wherein the receiver/decoder indirectly accesses the network via a gateway interposed between the receiver/decoder and a remote server.” Thus, instead of directly accessing the network via, for example, the Internet Protocol (IP), the receiver/decoder uses a proxy or gateway as a means to obtain access to the network.

Turning to the rejection, to establish a *prima facie* case of obviousness “...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (*See* MPEP §2143.03). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” (*See* MPEP §2143.03). The Applicant respectfully asserts that the references, when combined, fail to teach or suggest all the claim limitations of amended independent claims 1 and 18. Further, even assuming *arguendo* that the cited references teach all the claim limitations, there is no motivation to combine the references.

With respect to the failure of the cited references to teach all the claim limitations, the Examiner admits that White fails to teach or suggest that the receiver/decoder is not IP enabled. (*see* Office Action mailed January 9, 2006, page 3). It follows that White also cannot teach or suggest that the receiver/decoder indirectly accesses the network via a gateway, because the system of White has direct access to a network. Further, Greer fails to supply that which White lacks.

Specifically, the cited portion of Greer discloses a method for recording multiple channels received on a set-top-box. Greer discloses that multiple set-top-box cards are used to provide an *interface* between channel sources and a computer system with memory (DRAM) (*see* Greer, col. 6, ll. 52-55). As admitted by the Examiner on page 6 of the Office Action mailed January 9, 2006, Greer fails to disclose or suggest a gateway interposed between the receiver/decoder and the remote server. Furthermore, Greer is completely silent with respect any mechanism that would allow the set-top-boxes or set-top-box cards to access a *network*. Rather, Greer only discloses a single computer that is connected with the set-top-box cards or set-top-boxes (*see* Greer, Figures 1 and 2). The Applicant respectfully asserts that even the broadest reasonable construction of the term “network” cannot be used to encompass a single isolated CPU with DRAM memory.

Moreover, the Applicant notes that there is no motivation to combine the teachings of White and Greer. The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

In the present case, there is no expression of desirability in either White or Greer that would cause one skilled in the art to turn to the teachings of the other. The combination of White and Greer results in a WebTV terminal (disclosed in White), which is IP enabled, with the

added feature of receiving and recording television programs (disclosed in Greer). This combination – a WebTV terminal with functionality to receive and record TV programs – is clearly *IP enabled*. In the present invention, the receiver/decoder is combined with a gateway to result in an IP enabled receiver/decoder. That is, as a stand-alone, the receiver/decoder does not have IP functionality, but the addition of the gateway makes the receiver/decoder IP enabled. In contrast, the WebTV terminal of White inherent includes IP functionality. Therefore, it does not make sense to combine the WebTV of White with the system of Greer, which is not IP enabled. Furthermore, the system that results from the combination of the WebTV of White and the system of Greer would also be IP enabled, because there is no reason to remove the IP functionality inherently in the WebTV of White when combining the WebTV with another system or device. For the aforementioned reasons, it does not make sense to combine White and Greer to achieve the claimed invention.

In view of the above, it is clear that both White and Greer, whether considered separately or in combination, fail to render amended independent claims 1 and 18 obvious. Dependent claims 2-11 and 19-20 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 12-13, 21-22, and 29-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over White and Greer, and further in view of U.S. Patent No. 6,301,661 (“Shambroom”). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

As described above, White and Greer fail to teach or suggest all the limitations of amended independent claims 1 and 18. Further, Shambroom fails to supply that which White and Greer lack. Shambroom relates to providing enhanced security for applications employing downloadable, executable content (see Shambroom, col. 2, ll. 21-23). Shambroom fails to teach

or suggest a *receiver/decoder* that must indirectly access a network via a gateway because the receiver/decoder does not include IP functionality.


In view of the above, it is clear that amended independent claims 1 and 18 are patentable over White, Greer, and Shambroom, whether considered separately or in combination. Further, dependent claims 12-13, 21-22, and 29-30 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345/042001).

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Respectfully submitted,

By 
Jonathan P. Osha
Registration No.: 33,986
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant

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